



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,966	02/28/2002	Gerald D. Eckstein	8266-0823	3797

7590 10/21/2003

Bose McKinney & Evans LLP
Intellectual Property Group
2700 First Indiana Plaza
135 North Pennsylvania Street
Indianapolis, IN 46204

EXAMINER

KEASEL, ERIC S

ART UNIT	PAPER NUMBER
----------	--------------

3754

DATE MAILED: 10/21/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/085,966

Applicant(s)

ECKSTEIN ET AL.

Examiner

Eric Keasel

Art Unit

3754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-27, 40 and 55-63 is/are pending in the application.
- 4a) Of the above claim(s) 21, 25, 27 and 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-24, 26 and 55-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

DETAILED ACTION

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 41-49 have been renumbered 55-63.

Election/Restrictions

2. Claims 21, 25, 27, and 40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention (a system with multiple valves), there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 56 and 61-63 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

Art Unit: 3754

relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 56 recites that the lock is activated by pressure; however, the application (as filed) discloses that the lock is solenoid actuated. This is a new matter rejection.

Claims 61-63 recite, "the lever is movable into a first position wherein the first and second biasing mechanisms are equal". The first position is defined in claim 58 as the closed position. In the application as filed, neither in the closed position nor in any other position are the relative forces of the springs biasing the lever defined, much less defined as being equal. This is a new matter rejection.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 58-63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 58 recites "a first position" in lines 4 and 5. Claim 61 recites "a first position" in line 2. It is unclear if these are meant to be the same first positions or different first positions. If they are meant to be different, then subsequent recitations to "the first position" are unclear as to which first position is being referred to.

7. In light of the above informalities, the claims have been examined as could best be understood by the examiner. The examiner's failure to apply prior art to any of the claims should not be construed as an indication of allowable subject matter.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 26, 57, and 58 are rejected under 35 U.S.C. 102(b) as being anticipated by Pilolla (US Patent Number 5,358,213).

Pilolla discloses a valve assembly (10) with a manifold having an inlet (32), outlet (48), and a conduit (72) therebetween. A valve (110, 130) inhibits or permits flow between the inlet and outlet. A lever (182) is pivotally connected to the manifold (see ref. no. 189 and column 5, lines 33-37) and located entirely outside the conduit. A solenoid (140) is positioned between the manifold (which is defined as the areas with the inlet, outlet, and conduit therebetween) and lever and directly connected to the valve. The position of the lever is independent of the presence of the electrical input to the solenoid. Fig. 1 shows the valve closed, Fig. 2 shows the valve opened by the manual lever, and Fig. 4 shows the valve opened by electrical actuation of the solenoid (note the lever does not move). Re claim 58, the broadly worded biasing mechanisms can be read as the user's hand lifting the lever and gravity working in the other direction.

“[F]or a hospital bed”, “for positioning the bed”, “for a support device”, and “for positioning the support device” are intended use recitations. A recitation of the intended use of

Art Unit: 3754

the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 3754

11. Claims 22-24, 55, and 56 (as understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over Pilolla (US Patent Number 5,358,213) in view of McNabb (US Patent Number 5,487,493).

Pilolla discloses a valve assembly (10) with a manifold having an inlet (32), outlet (48), and a conduit (72) therebetween. A valve (110, 130) inhibits or permits flow between the inlet and outlet. A lever (182) is pivotally connected to the manifold (see ref. no. 189 and column 5, lines 33-37) and located entirely outside the conduit. A solenoid (140) is positioned between the manifold and lever and directly connected to the valve. The position of the lever is independent of the presence of the electrical input to the solenoid. Fig. 1 shows the valve closed, Fig. 2 shows the valve opened by the manual lever, and Fig. 4 shows the valve opened by electrical actuation of the solenoid (note the lever does not move).

Pilolla fails to disclose the lock engaging the lever (being a lock bar and a lock solenoid). McNabb discloses lock bar (29) and a lock solenoid (24) moving the lock bar to engage a lever (20) in a similar manual operated valve. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the lock bar and lock solenoid of McNabb in the valve assembly of Pilolla ('213) in the position where the lever is in the second, open position (see Fig. 2) in order to secure the lever in position as taught by McNabb.

Re claim 55, "integral" must be read broadly as applicant's lock only is indirectly connected to the lever through other parts in the non-engaging setting. The modified Pilolla meets the interpretation of "integral" consistent with applicant's disclosure. Re claim 56, if "pressure" is meant to be "solenoid actuated", then the modified Pilolla meets the claim.

Response to Arguments

12. Applicant's arguments filed 28 August 2003 have been fully considered but they are not persuasive.

Re claim 26, applicant argues that the solenoid of Pilolla ('213) is within the manifold. The manifold is defined as being the area containing the inlet, outlet, and conduit therebetween. This area is below the solenoid (i.e. the flow path does not go through the solenoid). Applicant presents an argument in which he interprets the solenoid of Pilolla as being in the manifold. This is not germane to the rejection of record, nor is it consistent with applicant's definition of manifold.

Re claim 22, applicant appears to misinterpret the claim and the Pilolla reference. Combining the lock bar (actuated by a lock solenoid) of McNabb to the lever actuator of Pilolla when in the position shown in Fig. 2. Applicant's argument appears to be in error. For such reasoning applied equally well to applicant's invention, which is a functioning device.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

Art Unit: 3754

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Keasel whose telephone number is (703) 308-6260. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Mancene can be reached on (703) 308-2696. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0861.

EK 20 OCT 03
ek
20 Oct 2003


Gene Mancene
Supervisory Patent Examiner
Group 3700